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Norris McLaughlin & Marcus, P.A.
220 East 42nd Street
30th Floor
New York, NY 10017

EXAMINER

ZIRKER, DANIEL R

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1771

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 051204

Serial Number: 09/750,984
Filing Date: December 28, 2000
Appellant(s): Tesa A. G.

Howard C. Lee
For Appellants

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EXAMINER'S ANSWER

GROUP 1700

1. This is in response to appellants' Brief on appeal filed March 1, 2004.

2. **(1) Real Party in Interest**

3. A statement identifying the real party in interest is contained in the Brief.

4. **(2) Related Appeals and Interferences**

5. A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the Brief.

6. **(3) Status of Claims**

7. The statement of the status of the claims contained in the Brief is correct.

8. (4) *Status of Amendments After Final*

9. The appellants' statement of the status of amendments after final rejection contained in the Brief is correct.

10. (5) *Summary of Invention*

11. The summary of invention contained in the Brief is deficient because although substantially correct with respect to claims 1-9 and 11-13, it fails to state that in claim 10 appellants claim a method for detecting unauthorized broaching of a package, which comprises sealing the package with the adhesive tape of claim 1, wherein when the adhesive tape is removed from the surface of the package, the adhesive tape is irreversibly destroyed and indicates an attempted broaching by tearing or splitting in the thickness direction.

12. (6) *Issues*

13. The appellants' statement of the issues in the Brief is substantially more complex than that set forth by the Examiner. More particularly, issues 1-3 as set forth by appellants will not be contested by the Examiner; issues 4 and 5, however, will be strongly contested. Additionally, appellants' characterization of issue 4, which reads "whether the rejection under 35 U.S.C. § 103(a) of claims 1-9 and 11-13 over appellants' admissions (page 3, lines 10-17 and page 6, lines 9-12) alone or in view of Allegre (FR 2749316) is proper" should also have stated that

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Allegre is relied upon only for the rejection of claim 3. The Examiner would also like to simplify issue 5 as stated by the appellants as stating "whether the rejection of 35 U.S.C. § 103(a) of claim 10 over Freedman (U.S. Patent 5,876,816 in view of appellants' admissions at page 3, lines 10-17 is proper".

14. **(7) Grouping of Claims**

15. The rejection of claims 1-9 and 11-13, as a first group, and claim 10, as a second group are agreed by the Examiner as involving separate issues of patentability and group 1 and group 2 do not stand or fall together. However, dependent claims 2-9 and 11-13 stand or fall together with claim 1 because appellants' Brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

16. **(9) Prior Art of Record**

17. The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

2,749,316	Allegre	December 5, 1997
5,876,816	Freedman	March 2, 1999

18. **(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-9 and 11-13 are rejected under 35 U.S.C.

§ 103(a) as being unpatentable over appellants' admissions in the specification at page 3, lines 10-17 and also (for claim 8) at page 6, lines 9-12, taken either individually, or alternatively for claim 3 in view of Allegre. The admission set forth at page 3, lines 10-17 of the specification is reproduced at page 9, first complete paragraph of appellants' Brief wherein while discussing adhesive tapes and adhesive tape backings in which the backing has more than one layer it is admitted that co-extruded polypropylene layers suitable for use as adhesive tape backings exhibit a weak bond of the film layers to one another, but by using polypropylene layers differing in such parameters as crystallinity or differing copolymers it is possible to vary the bond between the film layers. In this way it is possible to adjust the cleavage strength of the propylene based composite film, i.e., the adhesive tape, and to adapt it to the bond strength of the adhesive composition. It is noted that the admission fails to teach the utilization of "oriented" films, but such films are extremely well known in the packaging, adhesive tape and related arts. With respect to dependent claim 8 which claims the outer adhesive layer as an S-I-S adhesive, the admission on page 6 of the specification admits that such adhesives are well known in the art. With respect to Allegre, such embodiments as notches in the tape backing, which are set

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forth in appellants' dependent claim 3, are disclosed as known in the art by the French reference (e.g., see the Figure on the cover sheet of the reference). Finally, with respect to the dependent claims, parameters such as thicknesses, the presence of a primer layer, the amount of the release or adhesive coating, and the presence of corona discharge techniques are all well known to one of ordinary skill in the art.

2. Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Freedman taken in view of appellants' admissions in the specification at page 3 as set forth above. The reference clearly discloses (note particularly column 1, lines 5-9, column 2 line 37 - column 3 line 48, column 3 line 65 - column 4 line 6) a closely related multilayer tamper evident label in which the backing layers adhere to each other until they cleanly and readily separate under a suitable force. Appellants have argued previously that the reference is directed to tamper resistant labels, not adhesive tapes, but the Examiner respectfully submits that the label art and adhesive tape art are clearly analogous arts that teach very closely related structures and very often face the same general type of problems. That is, the Examiner firmly believes both that the reference is well within the field of the inventor's endeavor, and also is believed that the field of the reference is reasonably pertinent to the

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particular problem with which the inventors were involved. See In re Wood 202 USPQ 171. Additionally, it is further noted that the "oriented" limitation is again believed to be well within the ordinary skill of the art in the adhesive tape and tamper resistant label arts. As such, the Examiner believes that it would be well within the skill of the art to modify the tamper evident labels of Freedman in the manner suggested by appellants in their admission in the specification so as to form an adhesive tape as set forth in appellants' claim 1 and utilize it in methods shown in Freedman for detecting an unauthorized broaching of a package by utilizing tapes which delaminate.

19.(11) Response to Argument

1. Appellants argue in their Brief (page 9, last complete paragraph) that only the second sentence in the alleged admissions set forth on page 3 of the specification, i.e. "thus, it is known that films comprising non-heat-sealable, co-extruded, high crystalline polypropylene layers exhibit a weak bond of the film layers to one another." constitute an admission. The Examiner however must respectfully disagree since the following two sentences relied upon by the Examiner appear simply to finish the original observation started by the paragraph, and in essence disclose a complete anticipation of at least appellants' independent claim 1 except for the fact that the backing or film

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is not taught to be "oriented". However, even if one were to assume that appellants' position is correct and only the second sentence can be relied upon as an admission, the Examiner strongly believes that just this sentence would give one of ordinary skill in the art in this technically sophisticated field more than enough information to reduce the claimed invention to practice, since polypropylene backings using various polypropylene based compositions and their resultant behavior as backings are well known, and it is also firmly believed that to adjust the cleavage strength of the various polypropylene layers when one is aware that certain polypropylene layers exhibit weak bonds of the film layers to one another is also well within the skill of the art, as is to adapt this parameter to the bond strength of the adhesive layer on the backing to whatever value is desired. With respect to the rejection of claim 10 based upon Freedman taken in view of appellants' admissions it is noted that appellants' remarks (Brief, paragraph bridging pages 10-11) fail to appreciate that it is the admission, not the Freedman disclosure, that the Examiner is relying upon to disclose the "key limitation" that "it is accomplished with the adhesive tape of claim 1". Finally, with respect to the contention that "there is no teaching or suggestion to substitute the adhesive tape of the appellants' admission into the method of use described by

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Freedman" (Brief, page 11) the Examiner respectfully submits that this is the entire point of the analogous art based rejection relied upon by the Examiner. In summary, appellants have not rebutted the prima facie case of record.

20. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

APPEAL CONFEREE: Terrel Morris - Far

APPEAL CONFEREE: Dmr

DRZirker:cdc
(571) 272-1486
May 12, 2004

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1900~~
1700

Daniel Zinker

Howard C. Lee
Norris McLaughlin & Marcus PA
220 East 42nd Street
30th Floor
New York, NY 10017